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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/556,178	04/20/00	BANDMAN O	PF-417-US

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EXAMINER	
STEADMAN, D	
ART UNIT	**PAPER NUMBER**
1652	2

DATE MAILED: 05/11/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary	Application No.	Applicant(s)	
	09/556,178	BANDMAN ET AL.	
	Examiner	Art Unit	
	David J. Steadman	1652	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claims *1-20* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☐ Notice of References Cited (PTO-892)
16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
18) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
19) ☐ Notice of Informal Patent Application (PTO-152)
20) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 1, 2, 16, and 17, drawn to vesicle trafficking protein (VTP) polypeptides and pharmaceutical compositions thereof, classified in class 530, subclass 350.

   II. Claims 3-9, 11, and 12, drawn to polynucleotides encoding, host cells expressing, and a method for producing a VTP polypeptide, classified in class 435, subclass 69.1.

   III. Claim 10, drawn to an isolated antibody, classified in class 530, subclass 387.9.

   IV. Claims 13-15, drawn to methods for detecting a target polynucleotide in a sample, classified in class 435, subclass 6.

   V. Claims 18 and 19, drawn to methods for screening a compound for effectiveness as an agonist or as an antagonist, classified in class 435, subclass 7.1.

   VI. Claim 20, drawn to a method for screening a compound for effectiveness in altering expression of a target polynucleotide, classified in class 435, subclass 6.

2. The inventions are distinct, each from the other because:

The polynucleotides of Group II, the polypeptides of Group I, and the antibody of Group III each comprises a chemically unrelated structure capable of separate manufacture, use and effect. The polynucleotides of Group II have other utility besides encoding polypeptides such as hybridization probes, the polypeptides of Group I can be made by purification from the natural source, and the antibody of Group III can be used for purification of the polypeptide of Group I.

The polypeptide of Group I is unrelated to the method(s) of Groups IV and VI, the polynucleotide of Group II is unrelated to the method(s) of Group V, and the antibody of Group III is unrelated to the methods of Groups IV-VI as the polypeptide of Group I is neither used nor made by the method(s) of Groups IV and VI, the polynucleotide of Group II is neither used nor made by the method(s) of Group V, and the antibody of Group III is neither used nor made by the method(s) of Group IV-VI.

The polypeptide of Group I and the method of Group V or the polynucleotide of Group II and the methods of Groups IV and VI are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the polypeptide of Group I can be used as an antigen in the production of antibodies, or the polynucleotide of Group II can be used for protein expression.

The methods of Groups IV-VI are independent as they comprise different steps, utilize different products and yield different results.

3. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification(s), restriction for examination purposes is proper. "*For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation either separate classification, separate status in the art, or a different field of search as defined in MPEP 808.02*" (see MPEP 803). The above described inventions require divergent literature (patent and non-patent) and/or sequence searches, thereby establishing a different field of search.

4. Each of claims 1, 2, 5, 9, 11, and 17 are generic to a plurality of disclosed patentably distinct species comprising the polypeptides of SEQ ID NO: 1, 3, or 5, or the polynucleotides of SEQ ID NO: 2, 4, or 6. Each of these comprises a different amino acid or nucleotide sequence. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species, even though this requirement is traversed. Claims 3, 4, 6-8, 10, 12-16, and 18-20 included will be examined to the extent they read on the elected Group and species.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the Examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Steadman, whose telephone number is (703) 308-3934. The examiner can normally be reached Monday-Friday from 8:00 am to 4:30 pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ponnathapura

Achutamurthy, can be reached at (703) 308-3804. The FAX number for this Art Unit is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Art Unit receptionist whose telephone number is (703) 308-0196.

David J. Steadman

Rebecca Prouty

REBECCA E. PROUTY
PRIMARY EXAMINER
GROUP ~~1800~~ 1600